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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/424,521 02/15/00 NIELSEN

P ISIS-3070

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HM22/0517

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EXAMINER

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ART UNIT

PAPER NUMBER

11

1635

DATE MAILED:

05/17/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Advisory Action**

Application No.

09/424,521

Applicant(s)

NIELSEN ET AL.

Examiner

Thomas G. Larson, Ph.D.

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 April 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check only a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

4. ☐ 4. ☒ Applicant's reply has overcome the following rejection(s): see attachment.
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: \_\_\_\_\_
- Claim(s) objected to: \_\_\_\_\_
- Claim(s) rejected: 15-52
- Claim(s) withdrawn from consideration: \_\_\_\_\_
9. ☐ The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
11. ☐ Other:

Attachment to advisory action, paper no. 11

1. Applicant is required to update the continuing data portion of the specification to indicate whether the current application is a national phase filing, a continuation, or a continuation-in-part of the PCT/US98/10804 application and whether the PCT/US98/10804 application is a continuation or continuation-in-part of the 08/864,765 application.
2. Applicant's amendments to claims appear, upon entry, to overcome the rejections of claim 15 under 35 USC 102(b) in view of Thomson et al. The portion of the subject matter drawn to alkyl, lipid, and steroid groups appears to be disclosed in the parent applications (see '082 patent, col. 4, lns. 41-47) and is granted benefit of the filing date of these applications. It is not clear that the parental disclosures support a bridged-cycloalkyl group, such as adamantane, or an amino acid labeled with a fluorescent group. Therefore, this portion of the subject matter remains rejected under 35 USC 103(a) for the reasons set forth in the Office actions mailed 11/6/00 and 4/30/01.
3. The rejection under 35 USC 112, 1<sup>st</sup> paragraph, is maintained for the reasons of record in the Office actions mailed 11/6/00 and 4/30/01. Applicant appears to

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restate previous arguments which have already been addressed in the Office action mailed 4/30/01.

4. Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. The FAX numbers are (703) 308-4242 and (703) 308-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by the applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Unofficial papers, such as draft responses, may be transmitted to the examiner directly at (703) 305-7939. It is recommended that the examiner be notified when a fax is sent to this number.

Any inquiry concerning this communication or earlier communications should be directed to Thom Larson, whose telephone number is (703) 308-7309. The examiner normally can be reached Monday through Friday from 9:00 AM to 5:30 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached at (703) 308-0447.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist, whose telephone number is (703) 308-0196.

Thomas G. Larson, Ph.D.  
Examiner

  
ANDREW WANG  
PATENT EXAMINER  
TC 600